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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

FERTIG, BRIAN E

ART UNIT

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/710,856	<b>Applicant(s)</b> DORT, DAVID BOGART	
	<b>Examiner</b> BRIAN FERTIG	<b>Art Unit</b> 3694	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,5 and 7-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,5 and 7-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

This action is in response to Applicant's filing of 9/15/2008. Claims 1, 2, 5, and 7-9 are pending and examined below. Claims 3-4, 6, and 10-26 have been cancelled.

#### ***Specification***

1. 35 U.S.C. 112, first paragraph, requires the specification to be written in "full, clear, concise, and exact terms." The specification is replete with terms which are not clear, concise and exact. The specification should be revised carefully in order to comply with 35 U.S.C. 112, first paragraph. Examples of some unclear, inexact or verbose terms used in the specification are: par 70 "For example, a broker is looking to exchange commodity one for commodity to blood is on for many are with you to be in possession of commodity to broker who can enter the transactions space either through subscription or access membership enters the network looking for a seller of commodity to.", par 71 "One of the advantages of the present invention, in addition to being independent of currency fluctuations and political upheavals, is that taxation is difficult to ascertain for exchanges of commodities, and they bought a possible science, that do not easily translate into dollar or a correlated value.", par 72 "FIGS. 16-19 relate specifically to the second contemplated mode or embodiment of the invention in which the VPE may include one or more other portions that act as a personal asset investment attraction (IA). An individual may wish to have virtual personal economies configured for different scenarios, including allow others to "invest" or tie their valuable assets to their (pledge for exchange, a guarantee bank of assets, etc)"

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claim 1

Claim 1 recites limitations directed to 'securing'. Applicant's remarks of 9/15/2008, urge an interpretation of securing as "securitization. . . so that two virtual merchants may exchange goods or services with the benefit of a third parties wealth in non-currency assets. In exchange, the securitor takes a portion of the non-currency asset (which then can be exchanged for another)" (see remarked pertaining to claim 1 on the unnumbered first page of remarks)." In the context of the claim, there appear to be only 2 positively recited parties to the exchange, namely, the first and second electronic agents. As such, the claim is indefinite in light of Applicant's definition of the exchange. For the purpose of Examination below, it is assumed that there is an unclaimed additional party associated with the storage device and owned assets who is one of the two 'virtual merchants' of Applicant's definition. It is further assumed that the 'first electronic agent' is the other of the two 'virtual merchants', and that the 'second electronic agent' is the 'securitor' of Applicant's definition.

Further, Applicant's amendment replacing "an exchange module" with "said exchange module" causes the amended recitation to lack clear antecedent basis within

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the claim. For the purposes of Examination, it is assumed that the amended recitation is meant to find its basis in "a module executing a set of instructions" (sic). Additionally, the claim recites an outside asset or commodity, and later "said outside asset". It is assumed that the second recitation is meant to refer cumulatively to "an outside asset or commodity".

Further, based on Applicant's definition, it is assumed that the amended limitation "compensation in a commodity other than currency" is meant to limit how the securator is compensated, rather than characterize the transaction that the securtor is securing.

Further, in the context of the claim, the second electronic agent 'looks to' secure the outside assets, yet the exchange module is claimed to be capable of performing the securing. The claim is, therefore, indefinite as to which entity actually performs the securing.

Further, the claim recites the limitation that the securing is accomplished "by providing at least one set of owned assets", however, earlier in the claim the securing is claimed as related to said "outside asset". The claim is, therefore indefinite as to whether the securing feature secures the 'sell' side, 'buy' side, or both sides of the transaction.

### ***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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5. Claims 2, 5, 7 and 8 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. These claims are directed to a process (method). The Court of Appeals for the Federal Circuit in *In re Bilski*, Appeal No. 2007-1130, has affirmed that a statutory process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (i.e. the machine-or-transformation test). To qualify as a statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example, by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example, by identifying the material that is being changed to a different state.

Applicant is also directed to MPEP § 2173.05p, providing guidance with respect to reciting a product and process in the same claim and MPEP § 2111.02 [R3] providing guidance with respect to the effect of limitations within the preamble of a claim.

Examiner acknowledges the recitation of electronic catalog of assets, implying a machine and a network, however, the Office has taken the position that the machine used to satisfy the first prong of the machine-or-transformation test must perform more than "insignificant extra solution activity". As such, Examiner respectfully suggests positively reciting the performance of one or more significant processing steps by a machine (i.e. recite the performance of the linking step by a machine running the exchange module).

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 2, 5, and 7-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Perkes.

With respect to claim 2

Perkes teaches:

A method for generating an investment pool comprising the steps of:

cataloging a first set of one or more assets and configuring said catalog of assets into electronic form (i.e. cataloging coupons earned in Sponsor's database, see par 24, note that coupon's fairly suggest assets in so far as they embody value);

allowing said electronic first asset set catalog to be inspected over a network (i.e. displaying current amount of coupons in status bar, see par 34);

when selected, linking a second set of assets (i.e. pay-per-view content) represented in electronic form to said first set, such that the owner of said second set of assets has correlated the value of said second set of assets to said first set of assets with a normalization

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constant (see par 34, note that participating retailer sets cost of viewing pay-per-view content).

wherein said first set of assets (i.e. coupons) and second set of assets (i.e. pay-per-view content) are not currency (note that neither of these assets are currency, note further, as discussed above, the nature of the asset is non-functional descriptive material in so far as the method would be performed the same regardless of the nature of the asset, please note Examiner suggestion above).

With respect to claim 5

Perkes teaches:

The method as recited in claim 2 (see rejection of claim 2 above) further including the step of correlating said first set of assets and said second set of assets to a reference value. (see par 34, note that the content is mapped to the coupon is so far as a credit/coupon cost for the viewing of the content is maintained)

With respect to claim 7

Perkes teaches:

The method as recited in claim 5 (see rejection of claim 5 above) wherein said reference value is located on the same host system that includes access to said second set of assets (see par 25, note that both a single server and multiple servers are envisioned).

With respect to claim 8



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Perkes teaches:

The method as recited in claim 5 (see rejection of claim 5 above) wherein said reference value is not located on the same host system that includes access to said second set of assets. (see par 25, note that both a single server and multiple servers are envisioned).

With respect to claim 9

Perkes teaches:

An improved investment system including:

a computational device (i.e. Appliances, see par 25) linked to a network (i.e. computer network, see par 25) through a screening system, said screening system including at least one CPU and implementing an executable screening program (i.e. Appliance in combination with program software, see par 33);

electronic data storage configured to store first data that represents a non-currency assets (i.e. database, see par 24- 25, note that the database stores coupons which fairly suggest non-currency assets in so far as they embody value. Note further that the nature of the data stored is non-function descriptive material in so far as no-structural difference is required to store data of different nature. As discussed above, this limitation has been considered by not given patentable weight for distinguishing Applicant's invention from the prior art.);

a verification structure implemented with a computer and connected to a network that is configured to verify the existence and identification of said assets represented by said first data (i.e. Program Sponsor's server, see par 42, note the server stores the balance of coupons);

wherein said computational device loads said first data representational of said assets in response to a request received over said network and through said screening system (i.e. appliance in combination with program software loads coupon balance for display on status bar, see par 33-34) and correlates said first data representational of assets to second data representational of outside assets and said verification structure confirms that both said sets of data are properly correlated to said respective assets (i.e. the coupon cost relates the coupons to the pay-per-view content, see par 34).

### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 1 rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Application Publication 2002/0052788 for Perkes (Perkes) in view of US Patent 7,104,433 to Paul (Paul).

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With respect to claim 1

Perkes teaches:

A system implemented by one or more computational devices for conducting a transaction over a network comprising:

a data storage device (i.e. database), said data storage device including electronic representations of at least one set of owned assets' (i.e. digital coupons, pay-per-view content) said at least one set of owned assets including assets other than currency (see par 6, 25, and 34) ;

a module executing a set of instructions to map an outside asset or commodity (i.e. content) to said at least one set of owned assets (see par 34, note that the content is mapped to the coupon is so far as a credit/coupon cost for the viewing of the content is maintained);

an operative connection (i.e. Internet, see par 25) to both a first electronic agent looking to dispose of said outside asset (i.e. participating retailer appliance, see par 25) and

Perkes does not explicitly teach:

a second electronic agent looking to secure said outside asset or commodity in exchange for compensation in a commodity other than currency

said exchange module capable of securing a transition of said outside asset or commodity,

said securing at least accomplished by providing at least a portion of said at least one set of owned assets as security for said exchange, wherein said exchange module obtains approval from said second electronic agent via said network to use said at least one set of owned assets as security for said exchange, before said exchange occurs.

Paul teaches:

a second electronic agent looking to secure said outside asset or commodity, said exchange module capable of securing a transition of said outside asset or commodity (see col 4, lines 20-30),

said securing at least accomplished by providing at least a portion of said at least one set of owned assets as security for said exchange (see col 4, lines 20-30, note that the guarantor provides a payment guarantee, thus fairly suggesting its ability to stand in for the buyer and provide the portion of owned assets that the buyer would have otherwise paid),

wherein said exchange module obtains approval from said second electronic agent via said network to use said at least one set of owned assets as security for said exchange, before said exchange occurs (see col 6, lines 20-28, note that the guarantor may be responsible for transaction approval).

It would have been obvious to one having ordinary skill in the art at the time of Applicant's invention to have provided Perkes with the guarantor feature of Paul in order to have provided a payment guarantee to merchants on executed transaction in

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exchange for monetary considerations as taught explicitly by Paul (see col 4, lines 20-30)

Neither Perkes nor Paul explicitly teaches:

in exchange for compensation in a commodity other than currency

Paul teaches that it is well known for guarantors/secrurs to receive compensation.

However, the type of compensation received by the securor is non-functional descriptive material in so far as the type of compensation (i.e non-currency) does not require the claimed system to have a different structure from one accepting another type of compensation (i.e. currency). As such, the limitation has been considered, but not given patentable weight so as to distinguish Applicant's invention from the prior art. Should Applicant wish to differentiate the claimed invention based on this limitation, the Examiner respectfully suggests the inclusion of a claim to some structural difference that requires the compensation to be a commodity other than currency.

### ***Response to Arguments***

10. Applicant's arguments filed 9/15/2008 have been fully considered but they are moot due to new grounds of rejection or not persuasive. With respect to Applicant's argument that Perkes does not teach the securing feature of the claimed invention, Examiner agrees, however, Paul teaches that guarantors are well-known in the art.

With respect to Applicant's argument that claims 2, and 5-9 are directed to creating pools of VPE's, Examiner respectfully observes that the features upon which

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applicant relies (i.e., VPE's) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Further, the recitation of pooling has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

### ***Examination Note***

11. While the above claims do not currently contain allowable subject matter, the Examiner respectfully observes a number of unclaimed features in Applicant's Specification that could serve to differentiate Applicant's invention from the prior art. For example, the specification contemplates a data storage device that seems key to the invention that is in the nature of a USB device, Electronic Purse, or Smart Card.

12. Further, Examiner acknowledges a key feature of Applicant's invention as the non-currency nature of the transaction. As observed above, however, such a feature cannot be given patentable weight until it is positively claimed in some functional manner that requires the structure or steps of the invention to be performed differently as compared to the currency-type transaction. This might be accomplished, for

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example, by a rule processing feature that verifies that the asset is, in fact, non-currency. Examiner further respectfully notes that assets and transaction can be characterized as either currency or non-currency. As such, the mere substitution of non-currency features, such as are employed in bartering, for well-known currency based features is likely to be obvious, absent some additional distinguishing features.

### ***Inquiry***

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRIAN FERTIG whose telephone number is (571)270-5131. The examiner can normally be reached on Monday - Friday 8:30am to 5:00pm EST. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/B.F./

/Mary Cheung/  
Primary Examiner, Art Unit 3694